

**REMARKS**

**Petition for Extension of Time Under 37 CFR 1.136(a)**

It is hereby requested that the term to respond to the Examiner's Action of March 13, 2009 be extended one month, from June 13, 2009 to July 13, 2009.

The Commissioner is hereby authorized to charge the extension fee, and any additional fees associated with this communication to Deposit Account No. 50-4364.

In the Office Action, the Examiner indicated that claims 1 through 23 are pending in the application and the Examiner rejected all of the claims.

**Claim Objections**

On page 2 of the Office Action, the Examiner objected to claims 21-22 as being of improper dependent form, and on page 3 of the Office Action, the Examiner objected to claim 23 as being of improper dependent form. Applicant has cancelled claims 21 to 23 and respectfully submits that these objections are now rendered moot.

**The §101 Rejection**

On page 3 of the Office Action, the Examiner has rejected claim 23 under 35 U.S.C. §101, as being directed to non-statutory subject matter. As noted above, applicant has cancelled claim 23 and respectfully submits that this rejection is now rendered moot.

**Rejections under 35 U.S.C. §§102 and 103**

On page 5 of the Office Action, the Examiner rejected claims 1-5, 12-18, and 21-23 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0036914 to Fitzpatrick.

On page 9 of the Office Action, the Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as being unpatentable over Fitzpatrick and further in view of U.S. Patent No. 4,390,981 to Wood et al. On page 10 of the Office Action, the Examiner rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over Fitzpatrick and further in view of U.S. Patent Application Publication No. 2007/0165861 to Kuhl et al. On page 11 of the Office Action, the Examiner rejected claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over Fitzpatrick and further in view of Kuhl and U.S. Patent Application Publication No. 2004/0218045 to Bodnar et al. On page 12 of the Office Action, the Examiner rejected claims 19-20 under 35 U.S.C. §103(a) as being unpatentable over Fitzpatrick and further in view Bodnar.

In the attached amendment, Applicant has amended independent claim 1 to include the limitations of formerly-dependent claims 8 and 9, thereby rendering the rejection under 35 U.S.C. §102 moot.

**The Amended Claims are Non-Obvious**

KSR (*KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007)) requires that an Examiner provide “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” Further, an Examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does,” In addition, the Examiner must make “explicit” this

rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”

Fitzpatrick does appear to disclose a type of mutual contacts discovery system. In the examples described in Fitzpatrick, common contacts between two devices can be notified using a contact clearing house, as described with reference to Figures 1 to 4, or directly between devices, as described with reference to Figure 5.

In the claims, as amended, the subject matter of claims 8 and 9 have been incorporated into claim 1. Thus, independent claim 1 (and new claim 24, directed to a device) includes a hash key to be transmitted to the further device, which causes each of the devices to generate digests of contact entries in their contact stores using the hash key. The digests generated by the further device are transmitted to the (first) device, and the digests are used to compare the contact stores.

In the Office Action, the Examiner asserts that claims 8 and 9 are obvious over the combination of Fitzpatrick with Kuhl. Kuhl describes an RFID tag which, in response to the receipt of an interrogation signal, can transmit encrypted data to a receiver having a decryptor including stored decryption algorithms. The data received by the receiver is decrypted using the decryption algorithms to identify the type of RFID tag. The encrypted data transmitted by the tag is always used to identify the type of tag. However, it is also apparent from Kuhl that there is no transfer of a hash key between the tag and receiver because the document describes circumstances where the stored algorithms cannot identify the tag.

Contacts information is considered to be very private information because it is private data of the persons whose details are stored in the contacts stores of the devices. However, the exchange of this information under certain circumstances can be considered beneficial because a device user can discover whether he has a contact common to another user; another user who the user may never have met. This is described in the disclosure of Fitzpatrick.

In the present claimed invention, when the users decide to exchange contacts information, the respective devices each generate digests of the contacts in the respective contacts stores and only the digests are transferred between devices and used to discover common contacts, and this discovery process uses the hash key transmitted from one device to the other device. Therefore, the common contacts can be discovered without the transfer of the potentially sensitive contacts information. This is a particularly beneficial way of discovering common contacts, and is not disclosed or suggested by a combination of Kuhl and Fitzpatrick, as is suggested by the Examiner.

In view of the claim amendments and arguments submitted herein, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 6-11 and 19-20 under 35 USC §103 (and allow new claim 24).

### **Conclusion**

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge the extension fee, and any additional fees associated with this communication to applicant's Deposit Account No. 50-4364.

Respectfully submitted

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Date

/Mark D. Simpson/  
Mark D. Simpson, Esquire  
Registration No. 32,942

SAUL EWING LLP  
Centre Square West  
1500 Market Street, 38<sup>th</sup> Floor  
Philadelphia, PA 19102-2189  
Telephone: 215 972 7880  
Facsimile: 215 972 4169  
Email: MSimpson@saul.com